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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,118	04/14/2004	Haimanot Bekele	9209M	6444

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THE PROCTER & GAMBLE COMPANY
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EXAMINER	
WOLLENBERGER, LOUIS V	

ART UNIT	PAPER NUMBER
1635	

MAIL DATE	DELIVERY MODE
04/23/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/824,118	BEKELE ET AL.	
	Examiner	Art Unit	
	Louis Wollenberger	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2010 and 28 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed 4/28/2009 has been considered. Rejections and/or objections not reiterated from the previous office action mailed 1/28/2009 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

Claims 25-36, filed 4/28/2009, are pending and examined herein

Applicant's election of a single aminosilicone in claim 25 without traverse in the reply filed 3/2/2010 is acknowleged. Applicant elected the aminosilicone according to claim 25 wherein:

X is CH3

R is R'NHR"NH2

R' is isobutylene, and

R' ' is ethylene.

Applicant's previous elections, filed 10/4/2007, are applied to claims 26-36.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over DRECHSLER (US 6,139,823) in view of GAWTREY et al. (US 2003/0157049) and Nanba et al. (EP 0 829 254; of record).

DRECHSLER taught a cosmetic composition comprising anhydrous mixtures of an organosiloxane resin, a fluid polydiorganosiloxane polymer and a volatile carrier (see claim 1 and supporting disclosure, including cols. 1-2). Modified silicones, specifically aminosilicones (i.e. the amino alkyl side of silicone) are used in the cosmetic composition as a derivative of the polydiorganosiloxane. See e.g. claim 6 (amino alkyl side of silicone); instant claim 1. The

volatile carrier may be selected from the group consisting of hydrocarbon oils, silicone oils and mixtures thereof. See claims 14 and 17. The volatile carrier may specifically be isododecane. See claims 15 and 18, and Example 29. The composition described in Example 6 is anhydrous, as no water is used. See example 6, col 19; instant claim 1. Examples of thickeners used are propylene carbonate and bentonite clay. See e.g. example 29, col 34 line 66 to col 35 line 1; example 29 col 34 line 48; instant claims 2, 3 and 4. The organosiloxane resin comprises $R_3SiO_{1/2}$ "M" units, $R_2SiO_{1/2}$ "D" units, $RSiO_{3/2}$ "T" units and SiO_2 "Q" units, to satisfy the relationship $R_nSiO_{(4-n)/2}$ where n is from about 1.0 to about 1.50 and R is a methyl group. See e.g. claim 3; instant claim 5. The organosiloxane resin also comprises $R_3SiO_{1/2}$ "M" units and SiO_2 "Q" units, wherein the ratio of $R_3SiO_{1/2}$ to SiO_2 is about 0.7. See e.g. claim 7; instant claim 6. The use of the term "about" in the instant invention broadens the range of the ratio and is anticipated by the about 0.6 of the prior art. The diorganopolysiloxane polymer is polydimethyl siloxane. See e.g. claim 8; instant claims 1 and 8-11. The modified silicone has a viscosity of from about 100 cSt to about 2,000,000 cSt at 25 degrees C. See e.g. claim 11 line 4; instant claims 12 and 13. In certain embodiments, the viscosity is greater than 1,000,000 (claims 1 and 11). A topcoat is added over the composition as a complementary product, which can be any commercially available or developed product that increases the shine, gloss or lubricious nature of the lips. See e.g. col 10 lines 48-65; instant claim 1. Recommended topcoats include sucrose polyesters derived from sugar and vegetable oil (i.e., a polymeric vegetable oil emollient) (col. 11, lines 1-9). It is further disclosed that the fluid diorganopolysiloxane may comprise repeating units wherein said units correspond to the formula (R.sub.2 SiO), where R is a monovalent hydrocarbon radical containing from 1 to 6 carbon atoms of a fluoroalkyl and mixtures thereof

(col. 8), which is considered to be a modified silicone fluorinated polymer. With regard to claim 34, requiring a topcoat that is aminosilicone, the composition of claim 25 already includes an aminosilocone.

DRECHSLER et al. does not explicitly teach mixtures comprising aminosilicones as separate components in addition to any other diorganopolysilicone. However, this alone is considered a distinction with out a difference, since Dreschler et al. claimed and taught that their cosmetic compositions may comprise methyl, ethyl, amino alkyl, and fluoro alkyl modified diorganopolysiloxane as well as mixtures thereof in addition to an organosiloxane. Therefore, in fact, distinct polyorgano and amino modified silicones in a single cosmetic mixture were contemplated, claimed, and disclosed by Drechsler et al.

Further, as shown by Nanba et al. and Gawtrey et al., the prior art had taught that aminosilicones may be included as additional components in cosmetic formulations for the lips to obtain smooth spreading, easy application, and gloss. See page 6, lines 28-35. For example, Nanba et al. state:

> In addition to the aforementioned essential ingredients to obtain the effects of spreading smoothly and easily applied on the lips, not being sticky, having a nice gloss on the lips, having a long lasting cosmetic effect, and not causing color transfer onto coffee cups, clothes, etc., the lipstick composition of the present invention can contain other ingredients normally used in cosmetics and medicinal drugs as necessary within a qualitative and quantitative range where the effects of the present invention are not degraded. Examples include ion exchange water, dimethyl polysiloxane, methylphenyl polysiloxane, dimethylsiloxane -methylphenylsiloxane copolymers, high polymer gum -like dimethyl polysiloxane, silicones such as amino denaturated silicone and polyether denaturated silicone, animal oils such as lanolin, plant oils such as castor oil and olive oil, synthetic ester oils such as isopropyl myristate and glycerol tri-2-ethylhexanoate, waxes such as carnauba wax, candelilla wax, bees wax and hydrocarbon types, polyhydric alcohol-type humectants such as glycerine, propylene glycol and 1, 3 butylene glycol, various surfactants, thickeners, gelation agents, metal soaps, aqueous polymers, oil soluble polymers, drugs, antioxidants, pigments, dyes, pearl agents, organic/inorganic powders and perfumes.

In addition, GAWTREY et al. taught the use of both aminosilicones and separate and distinct polyorganosiloxanes, specifically a polydimethylsiloxane together in a cosmetic composition. See e.g. claim 1 and claims 38, 51-53: instant claims 1, 22 and 23. The

compositions of GAWTREY in one embodiment are used on the lips. See e.g. p[0504]. The conditioner (polyorganosiloxanes) affords at least one improved cosmetic property such as sheen. See e.g. Abstract.

Drechsler et al. do not teach the particular group of aminosilicones defined by the structure shown in instant claim 25.

However, the aminosilicones defined by Gawtrey et al. for use in the cosmetic formulations therein include species within the scope of those defined by instant claim 25. See the aminosilicones defined by formulas I and II described at paragraphs 21-33 and compare to the embodiments therein to those defined by claim 25 wherein X is OCH3, and R' and R" are "propylene" and "ethylene," respectively. Further, one of skill would reasonably predict that amino moieties in the repeating unit of the aminosilicone of the kind disclosed by Gawtrey et al. differing by only a single carbon atom would have substantially the same properties. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979).

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted).

Each of the elements recited by the instant claims for inclusion in a cosmetic composition had been taught by the prior art for use in a cosmetic formulations for use on the lip. It would have been prima facie obvious to combine any and all of these elements to produce a cosmetic formulation for the same use. More specifically, it would have been prima facie obvious to include aminosilicones, including any of those particularly described by Gawtrey et al., in any of the cosmetic formulations described by Drechsler et al. for any of the reasons disclosed by Nanba et al. See above.

Additionally, it is noted that Drechsler et al. taken alone claims and discloses cosmetic compositions comprising amino-, alkyl, and fluoro-modified diorganopolysiloxanes and mixtures thereof together with organosiloxane resins, and a volatile carrier. Together with the additional ingredients (thickeners and topcoatings) recommended by Drechsler et al. for inclusion in the basic cosmetic formulation described therein, one of skill, in the interest of improving sheen, gloss, and/or spreadibility, would reasonably have envisioned and would have been lead to make and use cosmetic compositions comprising each of the components specified by the instant claims.

Response to Arguments

Applicant's arguments filed on 4/28/2009 have been fully considered but are not persuasive.

Applicant argues the Drechsler-Gawtrey combination does not teach a cosmetic composition comprising the aminosilicone, organosiloxane resin, and diorganopolysiloxane polymer. The Examiner respectfully disagrees for the reasons given in the rejection above. The prior art (e.g., Nanba and Gawtrey) had taught that the inclusion of aminosilicones may improve the properties of cosmetic formulations for the lips. It would have been prima facie obvious to include aminosilicones,

including any of those particularly described by Gawtrey et al., in any of the cosmetic formulations described by Drechsler et al. for any of the reasons disclosed by Nanba et al.

Applicant also argues the Drechsler-Gawtrey combination does not teach the particular aminosilicone defined by instant claim 25. The Examiner respectfully disagrees, as explained above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Wollenberger whose telephone number is (571)272-8144. The examiner can normally be reached on M-F, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fereydoun Sajjadi can be reached on 571-272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Louis Wollenberger/

Primary Examiner, Art Unit 1635

April 20, 2010